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10/035,305	11/09/2001	Ruth Lipman	LIPM-3298	1972
5409	7590	03/15/2004	EXAMINER	
ARLEN L. OLSEN SCHMEISER, OLSEN & WATTS 3LEAR JET LANE SUITE 201 LATHAM, NY 12110			COE, SUSAN D	
		ART UNIT		PAPER NUMBER
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20040309

Application Number: 10/035,305

Filing Date: November 09, 2001

Appellant(s): LIPMAN, RUTH

Gerald F. Dudding
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 18, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. However, the appellant did not mention that an election of species requirement was issued in this application in the paper dated September 18, 2002. In response to this election of species requirement, the appellant elected Allium cepa (onion) for species A and lecithin for species B. Thus, at this time, the claims have only been examined in regards to these elected species.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The brief states that the claims stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

5,417,973 KING 5-1995

4,965,070 MESSINA 10-1990

JP 1-139515 A (6-1989)

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 and 6-12 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5,417,973 in view of US Pat. No. 4,965,070.

Appellant's claims are drawn to a method of repelling animals from plants by applying an extract of Allium cepa (onion) to a plant. The onion repellent composition can also include an egg and a preservative.

US '973 teaches a method of repelling animals using an onion extract. The repellent can also contain a preservative salt (see claims and column 2, first full paragraph). US '973 does not specifically teach applying the repellent to the same substrates that are claimed by applicant. However, a person of ordinary skill in the art would recognize that the repellent composition taught by US '973 could be used to repel animals from any surface that is known to be at risk for animal damage. Therefore, an artisan of ordinary skill in the art would be motivated to use the repellent of US '973 on the surfaces claimed by applicant.

US '973 also does not teach that the variety of onion used is the same as the claimed varieties. However, as disclosed by appellant's specification on page 4, all of these varieties of

Art Unit: 1654

onion are known varieties of onion. Therefore, any of these varieties could be used as the source of the onion used in the repellent of US '973.

US '973 also does not teach adding egg to their repellent. US '070 teaches that egg is an animal repellent (see column 2, last paragraph). Therefore, a person of ordinary skill in the art would reasonably expect that the addition of egg to the repellent of US '973 would be beneficial. Therefore, an artisan of ordinary skill would have been motivated to add egg to the repellent of US '973 based on the teaching of US '070. Lecithin would naturally be present in eggs.

Claims 1-3, 7, 11 and 12 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Pat. Appl. No. 1-139515 A in view of US Pat. No. 4,965,070.

JP '515 teaches a method of repelling animals using onion. However, JP '515 does not teach that the variety of onion used is the same as the claimed varieties. However, all of these varieties of onion are known. Therefore, any of these varieties could be used as the source of the onion used in the repellent of JP '515.

JP '515 also does not specifically teach adding a preservative to the repellent. It is known in the art to use preservatives in repellent composition. Therefore, a person of ordinary skill in the art would be motivated to add a preservative to the repellent of JP '515.

JP '515 also does not teach adding egg to their repellent. US '070 teaches that egg is an animal repellent (see column 2, last paragraph). Therefore, a person of ordinary skill in the art would reasonably expect that the addition of egg to the repellent of JP '515 would be beneficial. Therefore, an artisan of ordinary skill would have been motivated to add egg to the repellent of JP '515 based on the teaching of US '070. Lecithin would naturally be present in eggs.

(11) Response to Argument

In regards to the 103(a) rejection based on the combination of US Pat. No. 5,417,973 and US Pat. No. 4,965,070, the appellant argues that there is no motivation to combine the teachings of these two references together. The appellant argues that the combination is improper because US '973 teaches repelling pests such as insects and birds from animal carcasses while US '070 teaches repelling pests such as deer from plants. The appellant argues that the only means for modifying the teachings of the reference would be to either replace the carcass of US '973 with the plant of US '070 or add the plant of US '070 to the carcass of US '973. The appellant contends that such a replacement would destroy the teachings of the references because the substrate that is taught as needing protection is not present. The appellant argues that repelling animal from carcasses and plants are not analogous problems and that an animal that could potentially approach a plant would not necessarily approach an animal carcass.

The examiner disagrees with the appellant's arguments because there is proper motivation to combine the references. US '070 is concerned with the same problem as in appellant's claims, repelling animals from plants. To achieve this purpose, US '070 applies a composition comprising eggs and hot pepper sauce to the plant. The hot pepper sauce functions to repel the animal by acting as a respiratory irritant (see column 3, first paragraph). US '973 also teaches using hot pepper extract to repel animals from substrates that are potentially damaged by animals. The smell of the extract repels the animal from the substrate (see column 1, line 50). The reference teaches that onion extracts can be used in place of the hot pepper extract (see column 3, lines 3-6). Thus, from the teaching of US '973, a person of ordinary skill in the art would reasonably expect that hot pepper extracts and onion extracts function

equivalently in their ability to repel an animal from a substrate that needs to be protected from damage. Based on this reasonable expectation that onion extract will function equivalently to the hot pepper extract in US '070, a person of ordinary skill in the art would be motivated to substitute the hot pepper extract with an onion extract. Thus, this substitution would yield a method of repelling animals from plants using a composition that comprises onion extract and egg.

The appellant also argues that the examiner has not supported the assertion that the varieties of onion claimed by the appellant in claim 3 are known varieties of onion and that alliinase enzyme is inherently present in onion extract. However, the appellant's specification discloses that the varieties of onion claimed in claim 3 are known in the art, see page 4. The appellant has not offered any argument or evidence to show that substituting one known variety of onion for another known variety of onion gives the claimed invention novel features that make it patentable over the prior art. In addition, page 7 of the appellant's specification discloses that alliinase enzymes are responsible for the odors associated with onions. Thus, these enzymes are present in all onion.

In regards to the 103(a) rejection based on JP 1-139515 A and US Pat. No. 4,965,070 offers similar arguments to those used to rebut the combination of US '973 and US '070. The appellant argues that there is no motivation to combine the two references because JP '515 is concerned with repelling animals from garbage while US '070 repels animals from plants. However, as is the case in the above rejections, both JP '515 and US '070 use substances that smell unpleasant to the pest to achieve repellency. As discussed above, US '070 is concerned

with the same problem as in appellant's claims, repelling animals from plants. To achieve this purpose, US '070 applies a composition comprising eggs and hot pepper sauce to the plant. The hot pepper sauce functions to repel the animal by acting as a respiratory irritant (see column 3, first paragraph). JP '515 also teaches using pepper to repel animals from substrates that are potentially damaged by animals. The reference teaches that onion extracts can be used in place of the pepper (see English abstract "item a"). Thus, from the teaching of JP '515, a person of ordinary skill in the art would reasonably expect that pepper and onion function equivalently in their ability to repel an animal from a substrate that needs to be protected from damage. Based on this reasonable expectation that onion will function equivalently to the pepper in US '070, a person of ordinary skill in the art would be motivated to substitute the hot pepper extract with onion. Thus, this substitution would yield a method of repelling animals from plants using a composition that comprises onion and egg.

The appellant also argues that the examiner has not supported the assertion that the varieties of onion claimed by the appellant in claim 3 are known varieties of onion. However, the appellant's specification discloses that the varieties of onion claimed in claim 3 are known in the art, see page 4. The appellant has not offered any argument or evidence to show that substituting one known variety of onion for another known variety of onion makes the claimed invention patentable over the prior art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Susan D. Coe
March 9, 2004

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